

REMARKS / ARGUMENTS

Responsive to the requirement for an election of species as contained in the Office Action mailed from the United States Patent and Trademark Office on December 13, 2004. Applicant hereby elects, with traverse, claims 1 – 12.

In the restriction requirement of December 13, 2004, it is stated that the restriction to one of the following inventions is required under 35 U.S.C. § 121. The claims were placed into two groups in the office action as follows:

Group I. – Claims 1 – 12, drawn to a method for measuring or trimming, respectively, the impedance of driver device, classified in class 324, subclass 713.

Group II – Claims 13 – 16, drawn to a semiconductor device testing apparatus, classified in class 324, subclass 765.

The office action further states that “Inventions I and II are related as process and apparatus for its practice.”

For the reasons set forth in detail below, Applicant traverses the restriction requirement and respectfully requests reconsideration and withdrawal of the requirement. Further, Applicant reserves the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected claims. Applicant does not hereby abandon or waive any rights in the non-elected claims.

Criteria for Restriction

The necessary criteria for a proper restriction requirement have been clearly defined. Each restriction must meet two separate requirements. These requirements reflect both the statutory basis for restriction under 35 U.S.C. §121 and its discretionary nature. The criteria are described in the Manual of Patent Examining Procedure (MPEP) at § 803, in relevant part, as follows:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (. .)
or distinct as claimed (. .); and
- (B) There must be a serious burden on the
examiner if restriction is required (. .).

Applicant disagrees that restriction is required in this application between the two groups, because no serious burden would be placed on the Examiner.

As stated in the office action, claims 1 -12 are drawn to a method for measuring or trimming, respectively, the impedance of a driver device. There would not be any serious burden on the examiner to examine all the claims in the application, including the apparatus claims. The MPEP states in § 806.05(e), the section cited by the examiner, that “[i]f the apparatus claims include a claim to ‘means’ for practicing the process, the claim is a linking claim and must be examined with the elected invention.”

The withdrawn claims 13 recites “apparatus for performing a method for measuring and trimming the impedance of driver devices.” Claim 13 is clearly a linking claim. The apparatus claims should be examined.

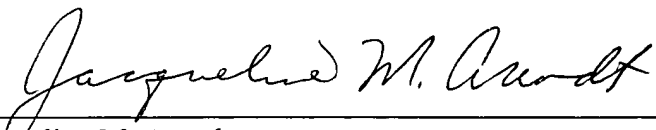
Conclusion

While the applicant has elected claims 1 – 12, claims 13 -16 should be examined in that there is no excess burden on the examiner to do so. Prosecution on the merits is respectfully requested. The foregoing is believed to be fully responsive to this office action. If a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned at (978) 897-8400.

Appl. No. 10/663,448
Docket No.:BGJ-102
Reply to Office Action of December 13, 2004

It is believed that no fee is due.

Respectfully submitted,
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